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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/910,108

07/20/2001

Takashi Yamanaka

S004-4348

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11/16/2005

ADAMS & WILKS

31st Floor

50 Broadway

New York, NY 10004

EXAMINER

LI, SHI K

ART UNIT

PAPER NUMBER

2633

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/910,108

Applicant(s)

YAMANAKA ET AL.

Examiner

Shi K. Li

Art Unit

2633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 06 October 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☒ Newly proposed or amended claim(s) 33 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 33.

Claim(s) objected to: _____.

Claim(s) rejected: 27,39-41 and 50.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: The Applicant's argument is not persuasive. The Applicant argues that it is unclear how the Examiner proposes to modify the optical equalizer of Fukushima to incorporate the piezoelectric devices of Wakabayashi. The Applicant then questions how would the piezoelectric devices of Wakabayashi be connected to the optical equalizer of Fukushima so that the piezoelectric devices displace the attenuator plate 6 along the Y-Z axes and rotate the attenuator plate 6 about the X axis, as required by Fukushima. The Examiner recognizes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Fukushima teaches in FIG. 16 to use drivers 32 and 34 to adjust a plurality of attenuating plates by moving the attenuating plates and Wakabayashi teaches that piezoelectric devices are preferable for replacing conventional solenoid type moving devices. Considered as a whole, Fukushima and Wakabayashi teach adjusting attenuating plates by using piezoelectric devices.

The Applicant then making the assumption that Examiner did not properly take into account the improvements in the optical communication device achieved by the claimed structure of the driving means disclosed in the specification. The Applicant states certain features of the claimed invention and concludes that one of ordinary skill in the art would not have been led to further modify Fukushima, as modified by Bornhorst, in view of Wakabayashi in the manner proposed by the Examiner in the statement of rejection. In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bornhorst teaches in FIG. 7 to dispose the optical plates on opposite sides of light beam path to make the apparatus compact and Wakabayashi et al. teaches piezoelectric actuator that does not generate electromagnetic noise and is stable and easy to produce. One of ordinary skill in the art would have been motivated to combine the teaching of Bornhorst and Wakabayashi with the optical equalizer because of the advantages mentioned above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Applicant states that claim 27 recites "driving control means for controlling the driving means to independently drive each of the optical parts between the first and second positions" and that the claimed "driving control means" must be construed to cover the structure recited in the specification and equivalents thereof. The Applicant then argues that Fukushima and Bornhorst do not disclose any type of piezoelectric device or self-excited oscillating circuit as recognized by the Examiner. However, the prior art references, considered as a whole, teach the function as recited in the means-plus-function limitation, therefore, the prior art references read on the limitation according to 35 USC 112, 6th paragraph.

The Applicant argues that it is unclear how the Examiner proposes to modify the optical equalizer of Fukushima to incorporate the piezoelectric devices of Slutskiy. The Applicant then questions how would the piezoelectric devices of Slutskiy be connected to the optical equalizer of Fukushima so that the piezoelectric devices displace the attenuator plate 6 along the Y-Z axes and rotate the attenuator plate 6 about the X axis, as required by Fukushima. The Examiner recognizes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Fukushima teaches in FIG. 16 to use drivers 32 and 34 to adjust a plurality of attenuating plate by moving the attenuating plate and Slutskiy teaches small, light weight and reliable piezoelectric devices. Viewed as a whole, Fukushima and Slutskiy teach adjusting attenuating plates by using piezoelectric devices.

The Applicant then argues that neither Fukushima, Bornhorst nor Slutskiy discloses or suggests "driving control means" (claim 27) and "control means (claim 39). However, the prior art references, considered as a whole, teach the function as recited in the means-plus-function limitation, therefore, the prior art references read on the limitation according to 35 USC 112, 6th paragraph..


M. R. SEDIGHIAN
PRIMARY EXAMINER